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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,583	07/24/2003	Kenichi Hayashi	240708US2	7738

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
WILLIAMS, ALEXANDER O	

ART UNIT	PAPER NUMBER
2826	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/625,583	HAYASHI ET AL	
	Examiner	Art Unit	
	Alexander O Williams	2826	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 October 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *9-14,16,17 and 20* is/are withdrawn from consideration.

5)☐ Claim(s) *1-8,15,18 and 19* is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Serial Number: 10/625583 Attorney's Docket #: 240708US2
Filing Date: 7/24/2003; claimed foreign priority to 7/26/02

Applicant: Hayashi et al.

Examiner: Alexander Williams

Applicant's election with traverse of species of figure 1A (claims 1-8, 15, 18 and 19) filed 10/18/04 is acknowledged. This species elected read on figures 1A to 7.

This application contains claims 9-14, 16, 17 and 20 drawn to an invention non-elected with traverse.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Figure 23A-23D should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claims 1-8, 15, 18 and 19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is confusing and unclear to what is meat by "said semiconductor device **being to be mounted** on an external electric member by inserting said leads" and "a third lead portion located at a position closer to the lead tip end than said second lead portion so **as to be inserted** into said lead-inserting portion." The claim language of "to be" does not describe permanent structure as part of the claimed device.

Any of claims 1-8, 15, 18 and 19 not specifically addressed above are rejected as being dependent on one or more of the claims which have been specifically objected to above.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Initially, and with respect to claims 8, 15 and 18, note that a "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re Fitzgerald, 205 USPQ 594, 596 (CCPA); In re Marosi et al., 218 USPQ 289 (CAFC); and most recently, In re Thorpe et al., 227 USPQ 964 (CAFC, 1985) all of which make it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that Applicant has burden of proof in such cases as the above case law makes clear.

Claims 1 to 8, 15, 18 and 19, **insofar as they can be understood**, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Woodworth et al. (U.S. Patent # 6,667,547 B2) in view of Damon et al. (U.S. Patent # 3,825,876).

1. Woodworth et al. (figures1 to 18) specifically figure 1 show a semiconductor device of an insertion-mount-type comprising: a plastic package **20**; a plurality of leads **25,26,27** protruding outward from said plastic package; a semiconductor element **22** protected by said plastic package; and electric wiring **41** protected by said plastic package to connect said semiconductor elements with said leads, wherein each of said leads includes a first lead portion **(portion before 30 closest to the package)** located at a plastic package side, a second lead portion **30** located at a position closer to a lead tip end than said first lead portion, and a third lead portion **(portion at the outer end of the leads 25-27)** located at a position closer to the lead tip end than said second lead portion so as to be inserted into said lead-inserting portion, the sectional area of said second lead portion is set to a value smaller than that of said first lead portion, and at least some of said leads are formed as gap controlling leads provided with gap-controlling means **(wide portion after 30)** to keep a gap between said semiconductor device and said external electric member constant, said gap-controlling means being located at a position closer to the lead tip end than said second lead portion, but fail to explicitly show said semiconductor device being to be mounted on an external electric member by inserting said leads into a lead inserting portion of said external electric member and joining said leads with said lead-inserting portion by solder.

Damon et la. Is cited for showing an electrical component mounting. Specifically, Damon et al. (figures 1 to 8) specifically figure discloses a semiconductor device being to be mounted on an external electric member **21** by inserting said leads **13** into a lead

inserting portion **46** of said external electric member and joining said leads with said lead-inserting portion by solder **(see abstract)** for the purpose of providing exceedingly economical means for connection of integrated circuits selectively in readily removeable or permanent soldered attachment.

2. The semiconductor device according to claim 1, the combination with Woodworth et al. showing wherein said gap-controlling means is formed by making the lead width thereof locally larger than the width of said second lead portion.

3. The semiconductor device according to claim 2, the combination with Woodworth et al. showing wherein said leads are arranged in a line at a side portion of said plastic package, only said leads at both ends of said line being formed as said gap-controlling leads.

4. The semiconductor device according to claim 2, the combination with Woodworth et al. showing wherein the thickness of said first lead portion is equal to that of said second lead portion, the width of said second lead portion being smaller than that of said first lead portion.

5. The semiconductor device according to claim 2, the combination with Woodworth et al. showing wherein the sectional area of said second lead portion is equal to that of said third lead portion.

6. The semiconductor device according to claim 2, the combination with Woodworth et al. showing wherein said gap-controlling means is formed in a shape protruding to both directions along a lead width direction.

7. The semiconductor device according to claim 6, the combination with Woodworth et al. showing wherein the lead width of said gap-controlling means is equal to that of said first lead portion.

8. The semiconductor device according to claim 7, the combination with Woodworth et al. showing wherein each of said gap-controlling leads is formed by linearly cutting said lead frame having a wide portion corresponding to said first lead portion, a narrow portion corresponding to said third lead portion, and a tie bar portion which connects said wide portion with said narrow portion and in which two holes are formed, and both of said holes are located at both sides of a range of said narrow portion along the lead width direction so that said holes are not present in said range, said holes being located on extension lines of both sides of said wide portion.

15. The semiconductor device according to claim 8, the combination with Woodworth et al. showing wherein each of said holes is a rectangular hole in which two opposite sides are parallel with the lead width direction or lead extending direction.
18. The semiconductor device according to claim 2, the combination with Woodworth et al. showing wherein each of said gap-controlling leads is formed by linearly cutting said lead frame having a wide portion corresponding to said first lead portion, a narrow portion corresponding to said third lead portion, and a tie bar portion which connects said wide portion with said narrow portion and in which two cutoff are formed at a position closer to said narrow portion, and said cutoffs are located at both sides of a range of said narrow portion in a lead width direction, said cutoffs being located on extension lines of both sides of said wide portion so as to be previously provided with said gap controlling means.
19. The semiconductor device according to claim 1, the combination with Woodworth et al. showing wherein each of said leads is coated with solder using tin as a base material without containing lead.

Therefore, it would have been obvious to one of ordinary skill in the art to use Damon et al.'s leads attachment to modify Woodworth et al.'s leads for the purpose of providing exceedingly economical means for connection of integrated circuits selectively in readily removeable or permanent soldered attachment.

As to the grounds of rejection under section 103, see MPEP § 2113.

The listed references are cited as of interest to this application, but not applied at this time.

Field of Search	Date
U.S. Class and subclass: 257/666,696,698,691,690,693,692,776,775,787,673,672,671,670 361/774,748,761,776,405 439/75 228/180 174/52.4	12/24/04
Other Documentation: foreign patents and literature in 257/666,696,698,691,690,693,692,776,775,787,673,672,6	12/24/04

71,670 361/774,748,761,776,405 439/75 228/180 174/52.4	
Electronic data base(s): U.S. Patents	12/24/04

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander O Williams whose telephone number is (571) 272 1924. The examiner can normally be reached on M-F 6:30-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272 1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alexander O Williams
Primary Examiner
Art Unit 2826

AOW
12/27/04